

REMARKS

1) Claims Status

Claims 38-48, 51-65 and 68-74 are pending. Claims 1-37, 49, 50, 66 and 67 were previously canceled without prejudice. Claims 38-48, 51-54 and 73 are currently amended to remove the phrase “or a solvate thereof.” No new matter is believed to have been entered.

2) §112, 1st para., Rejection - Enablement With Respect to “Solvates”

The claims have been rejected as not being enabled for “solvates” of the pyrazolone compounds claimed. As noted above, the claims have been amended to remove the phrase “or a solvate thereof.” Accordingly, Applicants request withdrawal of this rejection.

3) §112, 1st para., Rejection - Enablement With Respect to Certain Composition Claims

The Office alleges that the specification does not enable one skilled in the art to make and/or use the thrombopoietin receptor activators of claims 55-65 and 68-71, the pharmaceutical preparation comprising a thrombopoietin receptor activator of claim 72, and the platelet increasing agent comprising a thrombopoietin receptor activator of claim 73.

As support for this assertion, the Office notes that the “claim is drawn to thrombopoietin receptor activator, which has the intended use of preventive, therapeutic or improving agent for diseases against which activation of the thrombopoietin receptor is effective.” (page 7). The Office continues in its analysis by asserting that certain correlations between thrombopoietin activation and prevention/treatment of certain afflictions (i.e., thrombocytopenia resulting from HIV or chemotherapy) does not exist.

Applicants submit that the Office’s assertions regarding the correlations between thrombopoietin activation and certain afflictions are entirely misplaced in an enablement rejection of *composition* claims. As the Office has already recognized, the preamble of the claims in question (i.e., thrombopoietin receptor, pharmaceutical preparation and platelet increasing agent) are merely “intended uses” of the claimed compositions (see page 7).

Applicants note that the Patent Office's current position regarding statements of intended use is that "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (see MPEP 2106, IIC - emphasis added). Accordingly, the Office's enablement analysis with respect to the intended use of the *claimed compositions* is irrelevant to the patentability of *compositions* because intended uses do not limit the scope of the claims.

In view of the foregoing, Applicants request withdrawal of this rejection.

4) §102(a) Rejection

Claims 38-40, 51, 52, 55-57, 68, 69 and 72-74 are rejected as anticipated by Liu et al. As the Office has correctly noted on page 8 of the outstanding Office Action, this §102(a) rejection may be overcome by providing translations of the foreign priority documents for this application. Accordingly, Applicants submit herewith certified English translations of the following foreign priority documents: JP 2002-296468, JP 2003-278811 and JP 2003-285316. As such, Applicants request withdrawal of this rejection.

5) Conclusion

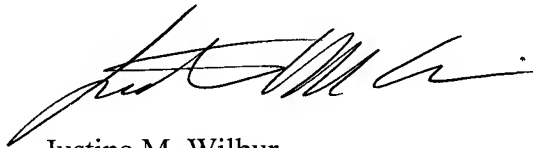
Applicants respectfully submit that the above-identified application is now in condition for allowance. Early notification to this effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)



Justine M. Wilbur
Registration No. 59,678